REMARKS

In the Office Action dated November 3, 2004, claims 1 – 22 stand rejected.

Applicants have herein amended claims 7 and 17, canceled claims 14 and 21, and added

claims 23 – 24. No new matter is introduced as a result of these amendments, support for

which is found within the specification as filed. Applicants respectfully submit that the

Examiner's rejections of the pending claims as set forth in the Office Action have been

overcome and that claims 1 – 14, 16 – 20 and 22 – 24 are allowable over the cited art for the

reasons set forth below.

A.   Provisional Double Patenting Rejection

Claims 1 – 22 stand provisionally rejected under the judicially created doctrine of

double patenting over claims 1, 5, 11 and 17 of co-pending Application No. 09/898,310,

which is commonly owned with the present application. The pertinent assignment document

for co-pending Application No. 09/898,310, a copy of which is attached hereto, has been

recorded by the USPTO on microfilm on Reel 012246, Frame 0400. Without acquiescing to

the Examiner's ground of rejection, Applicants file concurrently herewith a terminal

disclaimer in accordance with 37 CFR § 1.321(c). Applicants respectfully submit that the

filing of the terminal disclaimer overcomes the provisional rejection. Withdrawal of the

provisional rejection of claims 1 – 22 based on double patenting is respectfully requested.

B.   New Claims 23 –24

The subject matter of new claims 23 – 24 is fully supported by the original

specification as filed. For claim 23, Figures 2 and 3 clearly show a unitary portable data

storage device 70 that can be directly plugged into a universal serial bus (USB) socket of a

host computer. In Figures 2 and 3, the unitary portable data storage device 70 is clearly

shown to include a housing. Figure 1A and the corresponding description illustrate and describe a fingerprint module 50, while Figures 2 – 3 and 5 – 7 show that at least a portion of the fingerprint module 50 is housed within the housing and that fingerprint module 50 includes a sensor 52 disposed on an exterior surface of the housing. A non-volatile memory 20 is coupled to the fingerprint module 50 (Figure 1A) and is used to store fingerprint template(s) and user data (*see, e.g.*, page 6, lines 2 – 4; page 14, lines 9 – 10). A memory controller 14 is shown coupled to the memory 20 in Figure 1A and is used to control access to the memory 20 (*see, e.g.*, page 7, line 1). Figures 2 through 7 show a USB plug 18 that is integrated into the housing without an intervening cable and is capable of coupling the unitary portable data storage device 70 directly to a USB socket on a host computer. Figure 1A also shows a USB device controller 15 that enables and controls the communication between the unitary portable data storage device 70 with the host computer via the USB protocol (*see, e.g.*, page 7, lines 6 – 8). That the fingerprint module 50 is configured to receive a fingerprint sample from a user placing a finger on the sensor 52, to compare the fingerprint sample with at least one stored fingerprint template, and to reject a request from the user to access the user data stored in the memory device provided that the comparison results in no match are described, for example, in connection with steps 230, 240 and 260 of the flow diagram in Figure 10 and the corresponding description on pages 12 – 13. For claim 24, Figures 2 through 7 clearly show that at least a portion of the USB plug 18 protrudes from the integrated housing of the unitary portable data storage device 70, such that it facilitates direct coupling of the unitary portable data storage device 70 to a USB socket of a host computer. Applicants respectfully submit that no new matter is introduced by the addition of claims 23 – 24 and that they are allowable over the prior art of record for the reasons discussed below.

C. Prior Art Rejections

1. 35 U.S.C. § 102

Claims 1, 2, 4, 5, 7, 8, 10, 11, 13 –15, 17, 18, 20 and 21 stand rejected under 35

U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,088,802 (hereinafter "*Bialick*").

Applicants respectfully disagree with the Examiner's reading of the disclosure in *Bialick*,

which in Applicants' view fails to teach or disclose various claimed limitations of the

pending claims as amended. For instance, claim 1 of the present application recites:

> 1. A portable device comprising:
> a microprocessor;
> a non-volatile memory coupled to the microprocessor; and
> a biometrics-based authentication module coupled to and
> controlled by the microprocessor, wherein *access to the non-volatile*
> *memory is granted to a user provided that the biometrics-based*
> *authentication module authenticates the user's identity* and wherein
> *access to the non-volatile memory is denied to the user otherwise.*

(Emphasis provided).

Claim 1 recites a portable device having, among other elements, "a non-volatile

memory" and "a biometrics-based authentication module coupled to and controlled by the

microprocessor, wherein *access to the non-volatile memory is granted to a user provided*

that the biometrics-based authentication module authenticates the user's identity and

wherein *access to the non-volatile memory is denied to the user otherwise.*" Likewise,

claim 7 as amended recites a portable device having, among other elements, "a

microprocessor," "a non-volatile memory" and "a biometrics-based authentication module ...

wherein *the microprocessor is configured to disable access to the non-volatile memory*

upon a determination of authentication failure by the biometrics-based authentication

module." Applicants respectfully note that with these claim limitations, the claims in the

present application are directed to a portable device that includes a biometrics-based

authentication module for restricting access to information stored in the non-volatile memory

of the portable device.

The Examiner cites the discussion at col. 14, lines 50 – 52 in *Bialick* (a biometric device can be used "to enable user authentication to a host computing device before allowing access to particular data stored on the host computing device") for the proposition that *Bialick* teaches using the device disclosed to deny user access to information stored in the device. Applicants respectfully traverse. As the Examiner has noted in the Office Action, according to *Bialick*, biometric user authentication to a host computing device is made *before allowing access to particular data stored on the host computing device*. However, the cited reference to *Bialick* does not teach or disclose using biometric user authentication to *restrict access to information stored in the device itself*, as required by the claims in the present application. As such, Applicants respectfully submit that the pending claims in the present application, as amended, are not anticipated by *Bialick*.

For at least the foregoing reasons, *Bialick* does not anticipate independent claims 1, 7 and 17 and claims dependent therefrom, namely: claims 2 – 6; claims 8 – 14 and 16 – 20; and claims 18 – 20 and 22, respectively, of the present application.

As for new claim 23, *Bialick* does not teach or disclose, among other things, the claim limitation "a USB plug integrated into the housing without an intervening cable and capable of coupling the unitary portable data storage device directly to a USB socket on a host computer." Thus, claim 23 and claim 24, which depends from claim 23, are allowable over *Bialick* for at least this reason. Moreover, claim 24 requires, and *Bialick* does not teach or disclose, a unitary portable data storage device having a USB plug where at least a portion of the USB plug protrudes from the housing to facilitate direct coupling of the unitary portable data storage device to the USB socket. Claim 24 is therefore allowable over *Bialick* for this additional reason.

2.   35 U.S.C. § 103 – *Bialick*

Claims 6, 12, 16, 19 and 22 stand rejected under 35 U.S.C. § 103(a) as being

unpatentable over *Bialick*. Applicant respectfully disagrees with the Examiner's reading of

the disclosure in *Bialick* and submits that *Bialick* does not render the subject matter of claims

6, 12, 16, 19 and 22 obvious under 35 U.S.C. § 103(a).

The Examiner states that *Bialick* does not disclose a device having a microprocessor

configured to provide a bypass mechanism for authentication should the biometrics-based

authentication indicates a failed user authentication, as is required by claim 6. The Examiner

then suggests that it is obvious to modify *Bialick* to provide a bypass mechanism as claimed

and that *Bialick* provides the motivation for such modification. Applicants respectfully

disagree. That *Bialick* indicates it is desirable to establish "a layer of security that protects

the integrity of the security operations" (col. 10, lines 50 – 51) does not in any way suggest or

motivate the modification proposed by the Examiner. As such, Applicants respectfully

maintain that claim 6 is patentable over the cited reference.

The Examiner suggests that it is obvious to modify *Bialick* to come up with a device

that encrypts the first biometrics marker as claimed in claim 12 and that *Bialick* provides the

motivation for such modification. Applicants respectfully disagree. The generic statement in

Bialick that it is desirable to enhance the security of the biometrics-based access control

method does not in and of itself suggest or motivate the modification proposed by the

Examiner. As such, Applicants respectfully maintain that claim 12 is patentable over the

cited reference.

The Examiner states that *Bialick* does not disclose providing a bypass mechanism for

authentication should the biometrics-based authentication indicates a failed user

authentication, as is required in claim 16. The Examiner then suggests that it is obvious to

modify *Bialick* to provide a bypass mechanism as claimed and that *Bialick* provides the

motivation for such modification. Applicants respectfully disagree. For the same reason discussed above in connection with claim 6, Applicants respectfully submit that claim 16 is patentable over the cited reference.

The Examiner states that *Bialick* does not disclose storing the registered biometrics marker in an encrypted format, as is required by claim 19. The Examiner then suggests that it is obvious to modify *Bialick* to store the registered biometrics marker in an encrypted format as claimed and that *Bialick* provides the motivation for such modification. Applicants respectfully traverse. For the same reason discussed above in connection with claim 12, Applicants respectfully submit that claim 19 is patentable over the cited reference.

The Examiner states that *Bialick* does not disclose providing the user with a bypass authentication procedure when the no match is yielded by the comparison of biometrics markers recited in step (c), as is required in claim 22. The Examiner then suggests that it is obvious to modify *Bialick* to provide a bypass authentication procedure as claimed and that *Bialick* provides the motivation for such modification. Applicants respectfully disagree. For the same reason discussed above in connection with claim 6, Applicants respectfully submit that claim 16 is patentable over the cited reference.

3. 35 U.S.C. § 103 – *Bialick in view of Bjorn*

Claims 3 and 9 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Bialick* in view of U.S. Patent No. 6,799,275 (hereinafter "*Bjorn*"). Applicant respectfully disagrees with the Examiner's reading of the disclosures in both *Bialick* and *Bjorn* and submits that *Bialick* and *Bjorn*, alone or in combination, fail to teach or disclose various claimed limitations of claims 3 and 9.

The Examiner states that *Bialick* does not disclose a portable device with a USB connector for coupling with another USB-compliant device, as is required in claim 3. The Examiner also states that *Bialick* does not disclose a portable device with a USB device

controller coupled to the bus of the portable device and a USB connector coupled to the bus, such that the portable device is capable of communicating with a host platform via the USB connector, as is required in claim 9. *Bjorn* is then cited for the proposition that it discloses "... a data bus which conforms to a universal serial bus (USB) standard" (col. 2, lines 59 – 60). The Examiner further suggests that *Bjorn* provides the motivation to modify *Bialick* to include the USB device controller and USB connector as claimed in claim 3 and/or 9. Applicants respectfully disagree and submit that the mere statement in *Bjorn* that a data bus conforming to the USB standard can be used with the device disclosed therein does not in and of itself suggest or motivate the proposed modification of *Bialick*. As such, claims 3 and 9 are not render unpatentable in view of *Bialick* and *Bjorn*.

Thus, Applicants respectfully submit that claims 1 – 14, 16 – 20 and 22 – 24 are patentable over *Bialick* and *Bjorn*, alone or in combination, for the rationale discussed in detail above.

D. Conclusion

In view of the foregoing, Applicants respectfully submit that claims 1 – 14, 16 – 20 and 22 – 24 are fully supported by the specification as filed and are patentable over the cited art of record. As such, early notification of allowance of these claims is earnestly requested.

Respectfully submitted,

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